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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,281	09/30/2002	John F. Braun	F-521	5695

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER	
ROBINSON, MYLES D	
ART UNIT	**PAPER NUMBER**
2625	

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/065,281	BRAUN ET AL.	
	Examiner	Art Unit	
	Myles D. Robinson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The examiner has considered the references listed in the Information Disclosure Statements (IDS) submitted on 9/30/2002, 8/6/2004 and 9/20/2004 (see attached PTO-1449).

Drawings

2. The drawings were received on 12/23/2002 in regards to corrections made to Fig. 5. These drawings regarding Fig. 5 are acceptable.

3. However, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference character 62 (Fig. 1). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The attempts to incorporate subject matter into this application by references to U.S. Patent Applications entitled ***Method And System For Creating a Document Having Metadata*** (paragraph 0020), ***Method And System For Identifying a Form Version*** (paragraph 0021), ***Method And System for Remote Form Completion*** (paragraph 0022), and ***Method And System For Identifying a Paper Form Using a Digital Pen*** (paragraph 0023) are ineffective because the references are not clearly identified as required by 37 CFR 1.57(b)(2). Please update all incorporated references with current U.S. Patent Application serial and/or patent numbers.

5. The disclosure is objected to because of the following informalities: grammatical errors involving punctuation. It is suggested that "an available scannerA reference entitled" (paragraph 0006, line 7) be revised to read "an available scanner[.] A reference entitled" with an inserted period mark and appropriate spacing. Furthermore, it is suggested that "digital pen (not shown)Referring to FIGs. 4 and 5" (paragraph 0051, line 8) be revised to read "digital pen (not shown)[.] Referring to FIGs. 4 and 5" with an inserted period mark and appropriate spacing.

Appropriate correction is required.

Claim Objections

6. The following quotation of 37 CFR 1.75(a) is the basis of the objection:

> (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

7. ***Claim 8*** is objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Claim 8 recites the limitation "a pattern" in the claim after the limitation "a pattern" was claimed in line 2 of the parent claim 2. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to the same, instant "pattern" or a unique and distinctly different "pattern" within the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. ***Claims 1 – 8 and 11 – 13*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Black** (U.S. Patent No. 6,307,956) in view of **Andreasson** (U.S. Pre-Grant Publication No. 2002/0057824) and further in view of **Brooks *et al.*** (U.S. Pre-Grant Publication No. 2002/0107885).

Referring to **claim 11**, Black discloses a system for composing a facsimile comprising:

a processor (see Fig. 16, stylus 15 comprising computer chip 40, column 8, lines 1 – 5, column 10, lines 29 – 33),

a storage device connected to the processor,

the storage device storing a logic program, the processor operative with the logic program to perform:

capturing strokes made by a user writing with a digital pen (see Fig. 16, stylus 15 comprising computer chip 40, column 8, lines 1 – 5, column 10, lines 29 – 33) on a media having a pattern (column 17, lines 40 – 50), the strokes including indications of data including message data and command data (column 25, lines 36 – 54 wherein invention 10 is a pen based tool that uses word processing applications, i.e. message data, and can fax print documents, i.e. command data),

capturing user authentication information related to the user (see Figs. 2A – 2B, unique grip 30, column 7, line 37 – column 8, line 56, column 10, lines 29 – 65 and column 19, lines 47 – 63 wherein biometric information unique to the user, i.e. physical features, finger prints, voice recognition, DNA, point pressure, speed of signing, etc., is used to authenticate the user and stylus 15 includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed) but does not explicitly disclose the system comprising the logic program to perform processing the strokes in order to determine a recipient designated by the strokes, determining a template for the message using the strokes and the

pattern, and wherein the command data includes an indication of a send facsimile command.

Andreasson discloses the system further comprising the logic program to perform:

processing the strokes (see Fig. 2, user 100 uses pen 105 to fill in order coupon 103 in writing step 201, paragraph 0024, Fig. 1, computer 110 receives graph 120 containing recipient information entered, paragraph 0025) in order to determine a recipient designated by the strokes (see Fig. 2, pen 105 marks send box 104 to initiate sending step 203 to computer 110 utilizing mobile communication network 109, paragraph 0025, Fig. 1, mail 112 comprising printout 113 to be delivered to recipient mailbox 115, paragraphs 0027 – 0028), and

wherein the command data includes an indication of a send facsimile command (see Fig. 2, sending step 203, paragraph 0025) but does not explicitly disclose the system comprising the logic program to perform determining a template for the message using the strokes and the pattern.

Brooks et al. disclose the system further comprising the logic program to perform determining a template (see Fig. 4, form 160) for the message using the strokes (see Fig. 4, paragraph 0044 wherein pen-enabled computer device 10 comprising writing stylus 40 designates form 160 from a form-identification area 165) and the pattern (see Fig. 4, form-identification area 165, paragraph 0044 wherein pen-enabled computer device 10 comprising writing stylus 40 designates form 160 from a form-identification area 165).

Black, Andreasson and Brooks are combinable because they are both from the same field of endeavor, being pen-enabled computer devices within digital communication networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include designating appropriate forms using a stylus along with a pen-enabled computer device within a digital communication network. The suggestion/motivation for doing so would have been to reduce the noise distortion introduced in the scanning and/or faxing of paper forms, as suggested by Brooks et al. (paragraphs 0007 and 0010). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a pen to designate a recipient along with a pen-enabled computer device within a digital communication network. The suggestion/motivation for doing so would have been make mail order forms more convenient for those reading an advertisement in a publication, as suggested by Andreasson (paragraphs 0003 – 0005, 0008 and 0021).

Referring to **claim 12**, Black discloses the system further wherein the user authentication information includes biometric data (column 7, line 37 – column 8, line 56 wherein stylus 15 wherein stylus 15 includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed).

Referring to **claim 13**, Black discloses the system further wherein the biometric data includes pen stroke data including stroke pressure, stroke speed and pen attitude (column 7, line 37 – column 8, line 56 and column 19, lines 47 – 63 wherein stylus 15

includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed).

Referring to **claim 1**, Black discloses a method for composing a facsimile message comprising:

capturing strokes made by a user with a pointing instrument that include indications of data including message data and command data (column 25, lines 36 – 54 wherein invention 10 is a pen based tool that uses word processing applications, i.e. message data, and can fax print documents, i.e. command data) but does not explicitly disclose the method wherein processing the strokes in order to determine a recipient designated by the strokes determining a template for the message using the strokes and determining a template for the message using the strokes.

Andreasson discloses the method further comprising processing the strokes (see Fig. 2, user 100 uses pen 105 to fill in order coupon 103 in writing step 201, paragraph 0024, Fig. 1, computer 110 receives graph 120 containing recipient information entered, paragraph 0025) in order to determine a recipient designated by the strokes (see Fig. 2, pen 105 marks send box 104 to initiate sending step 203 to computer 110 utilizing mobile communication network 109, paragraph 0025, Fig. 1, mail 112 comprising printout 113 to be delivered to recipient mailbox 115, paragraphs 0027 – 0028) but does not explicitly disclose the method wherein determining a template for the message using the strokes

Brooks et al. disclose the method further comprising determining a template (see Fig. 4, form 160) for the message using the strokes (see Fig. 4, paragraph 0044 wherein pen-enabled computer device 10 comprising writing stylus 40 designates form 160 from a form-identification area 165).

Black, Andreasson and Brooks are combinable because they are both from the same field of endeavor, being pen-enabled computer devices within digital communication networks. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include designating appropriate forms using a stylus along with a pen-enabled computer device within a digital communication network. The suggestion/motivation for doing so would have been to reduce the noise distortion introduced in the scanning and/or faxing of paper forms, as suggested by Brooks et al. (paragraphs 0007 and 0010). Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a pen to designate a recipient along with a pen-enabled computer device within a digital communication network. The suggestion/motivation for doing so would have been make mail order forms more convenient for those reading an advertisement in a publication, as suggested by Andreasson (paragraphs 0003 – 0005, 0008 and 0021).

Referring to **claim 2**, Black discloses the method further wherein the pointing instrument is a digital pen (see Fig. 16, stylus 15 comprising computer chip 40, column 8, lines 1 – 5, column 10, lines 29 – 33) and strokes are provided by a user writing on a media having a pattern (column 17, lines 40 – 50).

Referring to **claim 3**, Black discloses the method further comprising capturing user authentication information related to the user (see Figs. 2A – 2B, unique grip 30, column 7, line 37 – column 8, line 56, column 10, lines 29 – 65 and column 19, lines 47 – 63 wherein biometric information unique to the user, i.e. physical features, finger prints, voice recognition, DNA, point pressure, speed of signing, etc., is used to authenticate the user and stylus 15 includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed).

Referring to **claim 4**, Black discloses the method further wherein the user authentication information includes biometric data (column 7, line 37 – column 8, line 56 wherein stylus 15 wherein stylus 15 includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed).

Referring to **claim 5**, Black discloses the method further wherein the biometric data includes pen stroke data including stroke pressure, stroke speed and pen attitude (column 7, line 37 – column 8, line 56 and column 19, lines 47 – 63 wherein stylus 15 includes biometric information measuring instruments such as pressures sensors to detect stroke pressure, i.e. point pressure, gyroscopes to measure the angle of the pen, i.e. pen attitude, and an accelerometer to measure stroke speed).

Referring to **claim 6**, Andreasson discloses the method further wherein the command data includes an indication of a send facsimile command (see Fig. 2, sending step 203, paragraph 0025).

Referring to **claim 7**, Andreasson discloses the method further wherein the send facsimile command (see Fig. 2, sending step 203) is indicated by the user writing a stroke (paragraph 0025, lines 1 – 3) in a segregated field (see Fig. 1, publication 101 comprising send box 104) of the media (paragraph 0025, lines 12 – 19).

Referring to **claim 8**, Brooks et al. disclose the method further wherein the template determination utilizes a pattern (see Fig. 4, form-identification area 165, paragraph 0044 wherein pen-enabled computer device 10 comprising writing stylus 40 designates form 160 from a form-identification area 165).

10. ***Claims 9 and 14*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Black** (U.S. Patent No. 6,307,956) in view of **Andreasson** (U.S. Pre-Grant Publication No. 2002/0057824) and further in view of **Brooks *et al.*** (U.S. Pre-Grant Publication No. 2002/0107885) and further in view of **Teppler** (U.S. Patent No. 6,895,507).

Referring to **claim 14**, Black, Andreasson and Brooks et al. disclose the system as discussed above in claim 13 but does not explicitly disclose the system wherein the data includes an attachment identifier, further comprising identifying the at least one attachment using the biometric data, authenticating the user using the user authentication information, and verifying user permission to access the attachment file.

Teppler discloses the system further wherein the data includes an attachment identifier (column 8, lines 41 – 50 and column 9, lines 26 – 53), further comprising:

identifying the at least one attachment (see Figs. 12a – 12b, document 1202 attached to e-mail 1204, column 18, lines 5 – 11 and 28 – 30) using the biometric data (see Figs. 5 and 7, verification means 580, column 32, lines 11 – 26),

authenticating the user using the user authentication information (see Figs. 5 – 8, fraud prevention means 560, column 32 lines 11 – 26), and

verifying user permission to access the attachment file (column 8, lines 51 – 65, column 9, lines 11 – 25, column 16, line 20 – 49, column 32, lines 1 – 10).

Black, Andreasson, Brooks and Teppler are combinable because they are both from the same field of endeavor, being digital identification and verification systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include identifying, authenticating and verifying attachment files along with a digital identification and verification system. The suggestion/motivation for doing so would have been to prove and preserve the integrity of digital data files and trusted timestamps, as suggested by Teppler (column 3, lines 18 – 29, column 4, lines 34 – 44, column 5, lines 9 – 56, column 11, line 53 – column 12, line 6, column 12, lines 39 – 58, column 14, lines 2 – 11 and 47 – 63).

Referring to **claim 9**, the rationale provided in the rejection of claim 14 is incorporated herein. In addition, the system of claim 14 performs the method of claim 9.

11. ***Claims 10 and 15*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Black** (U.S. Patent No. 6,307,956) in view of **Andreasson** (U.S. Pre-Grant

Publication No. 2002/0057824) and further in view of **Brooks *et al.*** (U.S. Pre-Grant Publication No. 2002/0107885) and further in view of **Teppler** (U.S. Patent No. 6,895,507) and further in view of **Bohan** (U.S. Pre-Grant Application No. 2003/0214681).

Referring to **claim 15**, Black, Andreasson, Brooks et al. and Teppler discloses the system as discussed above in the rejection of claim 14 but does not explicitly disclose the system comprising the processor operative with the logic program to perform determining determined message data using the attachment, and modifying the facsimile message using the determined message data.

Bohan discloses the system further comprising the processor operative with the logic program to perform:

determining determined message data using the attachment (see Fig. 3, computing device 104 comprising memory 302 with fax control program 318, Fig. 4, steps 406, paragraphs 0025 and 0031 wherein facsimile control program 318 determines the number of attached pages to enter on a cover page, i.e. message data, based the total number pages attached in the transmission, i.e. attachments), and

modifying the facsimile message using the determined message data (see Fig. 3, computing device 104 comprising memory 302 with fax control program 318, Fig. 4, step 408, paragraphs 0025 and 0031 wherein facsimile control program 318 modifies and generates a cover page, i.e. facsimile message, based upon the total number of pages attached in the transmission, i.e. determined message data).

Black, Andreasson, Brooks, Teppler and Bohan are combinable because they are both from the same field of endeavor, being digital communications systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include automatically determine the number of attachments and modify the message to include the number of attachments along with a digital communication system. The suggestion/motivation for doing so would have been to improve user convenience especially when using multiple data sources, as suggested by Bohan (paragraphs 0002 – 0004 and 0007).

Referring to **claim 10**, the rationale provided in the rejection of claim 15 is incorporated herein. In addition, the system of claim 15 performs the method of claim 10.

12. ***Claim 16*** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gannage *et al.*** (U.S. Patent No. 6,507,956) in view of **Teppler** (U.S. Patent No. 6,895,507).

Referring to **claim 16**, Gannage et al. disclose a system for sending a facsimile of a message (column 7, lines 17 – 24 and 50 – 53) comprising:

a receiver (see Fig. 1, note capture device 10) to receive pen stroke data from a digital pen (see Fig. 1, pen 16, column 5, lines 23 – 60) including attachment data indicating at least one attachment (column 6, line 45 – column 7, line 24),

a processor to process pen stroke data (column 4, lines 37 – 43), and

a file server connected to the processor (column 4, lines 37 – 43), wherein the processor uses pen stroke data to locate the at least one attachment (see Fig. 3A, steps

202 – 206, Abstract, column 4, lines 25 – 43, column 9, lines 1 – 8) but does not explicitly disclose the processor uses pen stroke data to verify permission to access the at least one attachments.

Teppler discloses the system further wherein the processor (see Fig. 5, computing means 520, verification means 580, fraud prevention means 560) uses pen stroke data to verify permission to access the at least one attachments (column 8, lines 51 – 65, column 9, lines 11 – 25, column 16, line 20 – 49, column 32, lines 1 – 10).

Gannage and Teppler are combinable because they are both from the same field of endeavor, being digital communications systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include verifying attachment files along with the transmission of digital files within digital communications systems. The suggestion/motivation for doing so would have been to prove and preserve the integrity of digital data files and trusted timestamps, as suggested by Teppler (column 3, lines 18 – 29, column 4, lines 34 – 44, column 5, lines 9 – 56, column 11, line 53 – column 12, line 6, column 12, lines 39 – 58, column 14, lines 2 – 11 and 47 – 63).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sesek *et al.* (U.S. Pre-Grant Publication 2005/0097337) disclose systems and methods for providing recipient-end security for transmitted data.

Norris, Jr. *et al.* (U.S. Pre-Grant Publication 2004/0134690) disclose a system and method for authenticating a mailpiece sender.

Coffy (U.S. Pre-Grant Publication 2006/0075340) disclose a packing list verification system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MDR 4/26/06

MDR

MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600